

REMARKS

Applicant has reviewed the Office Action mailed April 7, 2006, and offers the following remarks.

Status of the Claims

Claims 29-35 and 49-58 are pending. No claims are added, amended, or cancelled in this response.

Double Patenting Rejection

Claims 29-35 and 49-58 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 6,052,629. Applicant includes herewith a Terminal Disclaimer with respect to U.S. Patent No. 6,052,629.

Rejection of Claims 29-35 and 49-58 under 35 U.S.C. § 103(a)

Claims 29-35 and 49-58 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,717,374 to Smith (hereinafter "Smith") in view of U.S. Patent No. 6,505,170 to Seifert et al. (hereinafter "Seifert '170"). Applicant respectfully traverses.

For the Patent Office to combine references in an obviousness rejection, the Patent Office must do two things. First, the Patent Office must establish *prima facie* obviousness by showing where each and every element is taught or suggested in the combined references. MPEP § 2143.03. Second, the Patent Office must state a motivation to combine the references. The motivation must be supported with actual evidence which cannot come from Applicant's disclosure. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

Further, "[i]t is impermissible to use the claimed invention as an instruction manual or 'template' to pieced [sic] together the teachings of the prior art so that the claimed invention is rendered obvious . . . 'one cannot use a hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.' " *In Re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992), citing *In re Gorman*, 933 F.2d 982, 987 and quoting *In re Fine*, 837 F.2d at 1075.

In order to better clarify the issues involved with the present application, Applicant offers the following initial comments. Applicant respectfully asserts that the Patent Office has not established a *prima facie* case of obviousness, because all limitations required by Applicant's claims are not found within the combination of Smith and Seifert '170. Further, Applicant respectfully asserts that even if all elements were present, there is no motivation or suggestion within either Smith or Seifert '170, or within the art generally as it existed at the time of the present invention as claimed, to combine Smith with Seifert '170 or with any other reference to arrive at the claimed invention. Further, Applicant respectfully asserts that both Smith and Seifert '170 teach away from Applicant's invention as claimed and that any attempted combination will be the result of impermissible hindsight reconstruction. Each of these assertions is elaborated upon and described in more detail below.

In order to provide historical context to the present arguments, it is worthwhile to note that this application has been pending through its priority within the parent application for almost nine (9) years. Consumer products and sale terminals were vastly different at the time of the invention, as were the desires and expectations of consumers. In contrast to the present day where the Internet and the World Wide Web (WWW) have evolved to the point that most people know what they are, at the time of the invention, the Internet and the WWW were relatively new and unknown. While most people know what a browser is today, relatively few people considered surfing the web at the time of the invention. Further, technological advances in embedded computer display technologies are greatly improved over what was generally available to engineers and inventors at the time of the invention. During the 1990s, there were very few uses for any graphical imaging within embedded systems, such as an improved customer interactive device like that of the present application. A thin client represented within a browser using a markup language to present hypertext links to a consumer to allow the consumer to interactively manage navigation within the browser to make purchasing decisions was not generally available within the marketplace. Most displays used within embedded systems were character-only, text-based displays. Further, embedded systems seldom employed Ethernet or other protocol stacks that are used for Internet and the WWW, and were instead implemented with basic serial or parallel type interconnections.

It is within this historical context that Applicant respectfully submits that the Patent Office has engaged in improper hindsight reconstruction in order to attempt to cherry pick pieces

of the present invention as described and claimed by Applicant in order to form the present rejection. The references chosen still do not disclose each and every limitation of the present invention as claimed. However, prior to addressing the merits of the rejection, a brief summary of the present invention as claimed is presented in order to provide context for the arguments presented herein.

Present Invention

Claims 29, 49, and 58 of the present invention claim a web browser that is executed as a thin client on the interactive graphical user interface at a fuel dispenser. These claims also set forth that information is displayed to a customer at an interactive graphical user interface of the fuel dispenser in response to receipt of a markup language from a server or data source. This provides a consumer an enhanced interactive interface in the form of a thin client represented within a browser using a markup language to present hypertext links to the consumer to allow the consumer to interactively manage navigation within the browser to make purchasing and other decisions and service requests. As previously argued in Applicant's Response to the last Office Action filed on January 17, 2006, use of a markup language, such as hypertext markup language (HTML) or extended markup language (XML) for example, is used to provide basic documentation formatting of a web page and other information viewable in the web browser to allow a developer of these documents to specify links to other servers and files within the network, specifically the Internet/WWW network, that may be selected by users of the web page. Users of Applicant's invention as claimed may purchase movie tickets and other products or services in addition to fast food and car washes at a fuel dispenser by use of interactive video/graphic presentations provided to a customer by use of a web browser at the fuel dispenser. (See Specification, page 4, lines 3-13).

With Applicant's invention, new advertising and merchandising services that may be of interest to consumers can be deployed directly to the consumers at the fuel dispensers in a rapid fashion. By use of hypertext transfer protocol (HTTP) and a markup language, an advertiser can quickly change the appearance and information presented to the customer. Where previously, embedded software and hardware would need to be changed in order to change any features at a fuel dispenser, using Applicant's invention, these services may be deployed without a need to change hardware or software at the fuel dispenser. This results in a potential for significant cost

savings. Interactive video/graphic presentations may be rapidly provided to customers at fuel dispensers which may be immediately acted upon by customers to purchase the products or services advertised.

Smith

Smith includes a customer interface at a refueling station wherein the customer can enter alphanumeric, text-based information in response to text-based messages. The text-based messages are selected based upon information either obtained from alphanumeric, text-based information stored in a memory within the vehicle or entered by the customer.

As an initial observation, Applicant notes the Patent Office's acknowledgement on page 4 within the last paragraph of the Office Action mailed April 7, 2006 that Smith does not teach or suggest a thin client web browser interface. Applicant offers the following arguments addressing several other deficiencies of Smith in order to clarify the issues within the present application and to assist the Patent Office in arriving at a determination of allowance for the present application.

First, the Patent Office asserts that Smith teaches an "interactive graphical user interface." (See page 3 of Office Action mailed April 7, 2006). Applicant respectfully disagrees. Applicant has carefully reviewed Smith in the context of the time at which Smith was drafted and finds that Smith fails to disclose an interactive graphical user interface. Smith repeatedly describes sending messages between a vehicle and some type of remote terminal. All information transmitted is textual in nature including only alphanumeric information. For example, "messages are selected for inputting to the vehicle" (See col. 2, ll. 31-32). These messages are input to the vehicle "in accordance with information received from the vehicle, including . . . name, account number, address . . . make, model, year, class, registration number, marker number, odometer reading, owner, destination of the vehicle . . . ,"all of which include only alphanumeric information. (See col. 2, ll. 43-51). Accordingly, there is no teaching within Smith of displaying any graphical information.

Further, Applicant finds no teaching within Smith of a graphic display. Smith indicates that "[i]n response to the information that is transferred from the vehicle 1, the remote station 52 is enable [sic] to select one or more messages from one or more message sets. . . . The message or messages can be displayed at the local station 50, or can be inputted to the vehicle for storage,

display and possible printing.” (See col. 10, ll. 11-19). Smith also indicates that a “data output device, such as an LCD display” can be used to display the information to the user. (See col. 6, ll. 41-42). Taking the teachings of Smith as a whole, it is evident that Smith intends to display only alphanumeric messages in association with the alphanumeric information entered by a user as described above, and does not intend to display any graphical imagery. The data output device of Smith may be either an LCD display or a video monitor, but there is no teaching of any graphical information displayed on either device. Further, the data entry device 30 and 1d of Figures 1b and 2b, and Figures 6 and 9, respectively, are used to enter alphanumeric data as described above. There is no mouse or other pointing device described within Smith and there is no graphical data displayed. Accordingly, Smith does not disclose an interactive graphical user interface.

Second, the Patent Office asserts that Smith teaches a “thin client on said interactive graphical user interface (fig 9, element 52a).” (See page 3 of Office Action mailed April 7, 2006). Applicant respectfully disagrees. Applicant maintains the argument presented in Applicant’s Response to the previous Office Action, filed on January 17, 2006, that “element 52a is merely demonstrating a communication network that allows for the exchange of information.” (See previous response, page 3). Applicant respectfully maintains that element 52a is not a thin client. Further, because Smith does not disclose an interactive graphical user interface, it would be impossible for Smith to disclose this element as claimed.

Third, the Patent Office asserts that Smith teaches “displaying information at the graphical user interface in response to receipt of a markup language from a server” (See page 3 of Office Action mailed April 7, 2006). Applicant respectfully disagrees. As described above, because Smith does not disclose a graphical user interface, Smith cannot display information at a graphical user interface. Further, Applicant maintains the argument presented in Applicant’s Response to the previous Office Action, filed on January 17, 2006, that “[a]lthough Smith discloses transferring files in, shown as element 52b of Figure 9, Smith does not disclose that these files are exchanged by implementing a web browser that enables a customer to interact with markup language files.” (See previous response, page 3).

Seifert '170

Seifert '170 describes an interface on an operator-managed point-of-sale (POS) device that is not a fuel dispenser and that is not a customer interactive device like that of the present invention. Seifert '170 describes point-of-sale (POS) devices, such as money order dispensers (MODs), managed by a remote host. (See Abstract, Figure 2, and col. 4, ll. 40-42). Referring to Figure 1, POS system 3 includes a POS Device 4, a cash register 5, a personal computer ("PC") 6, and an electronic safe 7" (See Figure 1 and col. 4, ll. 12-14). An operator of a store can use "Cash Register 5 and/or an alternative conventional control terminal to operate POS device 4." (See col. 4, ll. 15-17). The POS device in Seifert '170 is inside a retail convenience store environment and is not at a customer-interactive fuel dispenser.

Unlike Applicant's invention, in which new advertising and merchandising services that may be of interest to consumers can be deployed directly to the consumers at the fuel dispensers in a rapid fashion via a web browser, Seifert '170 is designed to be used by a store clerk and is located inside the convenience store – not at the fuel dispensers. Store clerks using Seifert '170 can use Cash Register 5 to interact with a POS terminal and the store safe.

Consumers do not interactively interface with the POS terminal, because they do not have access to the cash register. Customers would certainly not be given access to the cash register of the store in order to control the POS terminal. Additionally, customers would certainly not be given access to the store safe which would also result if customers had access to the cash register and the POS terminal. Accordingly, Seifert '170 teaches the use of a POS terminal by a store clerk only and does not teach use of a POS terminal on which new advertising and merchandising services that may be of interest to consumers can be deployed directly to the consumers at the fuel dispensers in a rapid fashion. Seifert '170 is targeted to a different use entirely and is vastly different from Applicant's invention.

All Limitations are Not Found within the Combination of Smith and Seifert '170

Based upon the arguments presented above, Applicant respectfully submits that all of the limitations of each of Applicant's independent claims 29, 49, and 58 of the present invention are not found within Smith and Seifert '170, either alone or in combination.

Applicant provides a consumer with an enhanced interactive interface in the form of a thin client represented within a browser using a markup language to present hypertext links to

the consumer to allow the consumer to interactively manage navigation within the browser to make purchasing decisions. As described above, many limitations of Applicant's claims are not present within the combination of Smith and Seifert '170.

Smith provides a text-based, alphanumeric interface for use by a consumer at a fueling station. Smith does not teach or suggest the use of any graphical imagery, and does not teach or suggest use of a markup language to allow a consumer to interact with the system. Seifert '170 provides a browser at an operator-managed terminal associated with an automatic money order dispenser. Seifert '170 does not provide a browser that can be used by a consumer as part of a transaction. Neither Smith nor Seifert '170 teach or suggest providing a consumer with an enhanced interactive interface in the form of a thin client represented within a browser using a markup language to present hypertext links to the consumer to allow the consumer to interactively manage navigation within the browser to make purchasing decisions.

Accordingly, Applicant respectfully submits that the rejection of claims 29, 49, and 58 should be withdrawn for at least the reasons specified above. Further, dependent claims 30-35 and 50-57 each depend from one of independent claims 29 and 49. Accordingly, Applicant respectfully submits that the rejection of claims 30-35 and 50-57 should also be withdrawn for at least the same reasons. Accordingly, Applicant respectfully submits that all claims are in proper condition for allowance and Applicant respectfully requests notice of the same at the earliest possible date.

Although not required since the Patent Office has not established a *prima facie* case of obviousness, Applicant offers the following additional arguments against the rejection.

No Motivation or Suggestion to Combine

The Patent Office provides no statement of a motivation or suggestion to combine the references within the Office Action mailed April 7, 2006. As described above, in addition to showing where each and every element is taught or suggested in the combined references, which Applicant respectfully asserts that the Patent Office has not done, the Patent Office must also state a motivation to combine the references and the stated motivation must be supported with actual evidence which cannot come from Applicant's disclosure. The Patent Office has neither stated a motivation or suggestion to combine the references, nor has the Patent Office provided

any evidence of a motivation or suggestion to combine the references. Accordingly, the Patent Office has failed to meet its burden of establishing a *prima facie* case of obviousness.

Further, none of Smith, Seifert '170, or the art generally at the time of the present invention provide any motivation or suggestion to combine the two references. As described above, Smith provides a text-based system and provides no suggestion or motivation to combine its teachings with a POS device like that in Seifert '170 in order to implement a web browser that enables a customer to interact with markup language files. As evidence that Smith provides no suggestion or motivation to combine its teachings in order to implement a web browser that enables a customer to interact with markup language files, Applicant reiterates that Smith describes communicating only alphanumeric information.

Additionally, Seifert '170 describes a system for use by a clerk and provides no suggestion or motivation to combine its teachings with Smith's non-browser-based fuel dispenser interface in order to implement a web browser at a fuel dispenser that enables a customer to interact with markup language files. As evidence that Seifert '170 provides no suggestion or motivation to combine its teachings in order to implement a web browser that enables a customer to interact with markup language files, Applicant reiterates that Seifert '170 describes a system that gives a store operator access to the cash register and safe inside a convenience store — not at a fuel dispenser.

The art generally does not cure any of the deficiencies associated with Smith and Seifert '170. As evidence that the art generally provides no suggestion or motivation to combine the two references, hypertext links embodied within a web page were not even common knowledge at the time of the present invention.

Accordingly, Smith, Seifert '170 and the art generally at the time of conception of the present invention as claimed provide no suggestion or motivation to combine with any other reference in order to implement a web browser that enables a customer to interact with markup language files. Applicant respectfully submits that any attempted combination would be improper.

Smith Teaches Away from any Combination

Smith states that information entries received from a remote server are "preferably stored in the memory 1b wherefrom they can be individually retrieved by the occupant via the data

entry console 1d.” (See col. 12, ll. 19-21). In contrast to the present invention as claimed, where information is displayed “in response to receipt of a markup language from a server . . .” or by “interpreting a markup language . . .,” Smith describes receiving discrete parcels of information rather than receiving or interpreting a markup language. The step of preferably storing the information received for later display teaches away from a web browser interface that presents information in real time as it is received. Therefore, Smith describes storing discrete items of information in a memory on a vehicle in response to receipt of the discrete items of information which are not received within a markup language. Further, Smith teaches away from use of a markup language. Accordingly, any attempted combination of Smith with any reference that describes use of a web browser would be contrary to the teachings of Smith for at least these reasons.

Seifert ‘170 Teaches Away from any Combination

Seifert ‘170 teaches away from any combination of the POS terminal of Seifert ‘170 with a fuel dispenser. In contrast to the present invention as claimed, where information is displayed to a customer at an interactive graphical user interface associated with a fuel dispenser, Seifert ‘170 describes monitoring a gas pump with the POS that is operated by the store clerk. As evidence of the fact that Seifert ‘170 teaches away from the combination, Seifert ‘170 indicates that the “POS device may . . . poll and check the status of other devices . . . (e.g., a . . . gas pump).” (See col. 13, ll. 36-39). Accordingly, any attempted combination of Seifert ‘170 with any reference that describes interactivity with a customer at a fuel dispenser would be contrary to the teachings of Seifert ‘170 for at least these reasons.

Impermissible Hindsight Reconstruction

Applicant respectfully asserts that the Patent Office has engaged in impermissible hindsight reconstruction in order to attempt to piece together the elements of Applicant’s claims to form the present rejection. As evidence that the Patent Office has engaged in impermissible hindsight reconstruction, Applicant respectfully submits that the arguments presented above show definitely that there is no motivation or suggestion to combine the references, either within the references themselves or within the art generally during the 1990s.

Applicant understands that it is difficult to place oneself back in time to period almost a decade ago. However, the legal standard is definitive. “It is impermissible to use the claimed

invention as an instruction manual or 'template' to pieced [sic] together the teachings of the prior art so that the claimed invention is rendered obvious . . . 'one cannot use a hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.' " *In Re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992), citing *In re Gorman*, 933 F.2d 982, 987 and quoting *In re Fine*, 837 F.2d at 1075. Applicant respectfully asserts that all claims are in proper condition for allowance and notice of the same is respectfully requested at the earliest possible date.

Seifert '170 is Not Prior Art

Although the combination of Seifert '170 with Smith is deficient for the reasons stated above, Seifert '170 must be removed because it is not prior art. The Patent Office has attempted within the present Office Action to combine Smith with Seifert '170 in order to construct the present rejection. However, in addition to the deficiencies of Seifert '170 argued above, Seifert '170 cannot be used as relied upon by the Patent Office, because Seifert '170 is a continuation-in-part application based upon a parent application, U.S. Patent No. 6,015,087 to Seifert et al. (hereinafter "Seifert '087"), that does not include the subject matter relied upon by the Patent Office in order to make the present rejection. Applicant has carefully compared the disclosure of Seifert '170 with that of Seifert '087 and has found that the teachings relied upon in Seifert '170 as the basis of the present rejection are not present within the Seifert '087. Accordingly, the teachings relied upon by the Patent Office within Seifert '170 can only be used as of the filing date of Seifert '170 to form the basis of any rejection, which is April 10, 1997. Applicant previously entered a 37 CFR § 1.131 affidavit establishing a date of invention prior to October 21, 1996. Accordingly, Seifert '170 is not prior art and cannot be used to form the basis of any rejection of the present application.

Additional Comments

Applicant reserves the right to provide additional arguments if necessary in relation to any of the rejected claims. Accordingly, Applicant respectfully submits that claims 29-35 and 49-58 are in proper condition for allowance and notice of the same is respectfully requested at the earliest possible time.


Conclusion

In view of the discussion above, claims 29-35 and 49-58 are now in proper condition for allowance. Reconsideration is respectfully requested and notice of allowance for all pending claims is respectfully requested at the earliest possible date. If any issues remain, the examiner is encouraged to contact the undersigned attorney of record to expedite allowance and issue.

Respectfully submitted,

WITHROW & TERRANOVA, P.L.L.C.

By:



Steven N. Terranova
Registration No. 43,185
P.O. Box 1287
Cary, NC 27512
Telephone: (919) 654-4520

Date: July 3, 2006

Attorney Docket: 2400-505

<p><u>CERTIFICATE OF TRANSMISSION</u> I HEREBY CERTIFY THAT THIS DOCUMENT IS BEING TRANSMITTED VIA FACSIMILE ON THE DATE INDICATED BELOW TO:</p> <p>Examiner: <u>Thu Thao Havan</u> Art Unit <u>3624</u> Fax: <u>571-273-8300</u></p> <p><u>Kelly Farrow</u> Name of Sender</p> <p><u>[Signature]</u> Signature</p> <p><u>7/3/06</u> Date of Transmission</p>
